

REMARKS

Applicant would like to express appreciation to the Examiner for the detailed Official Action provided. Upon entry of the present amendment, claim 12 will have been amended and claims 13-15 will have been added. Claims 1-15 remain pending in the present application. Applicant notes that in accordance with a telephone conversation with the Examiner on May 14, 2003, claim 12 has been amended to conform the marked-up and clean copies to each other, and to re-introduce subject matter (*i.e.*, the recording means/recorder) that was inadvertently left out of this re-typed claim, in the Amendment submitted on July 10, 2002.

The Examiner has rejected claims 1-5 and 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,390,003 to YAMAGUCHI, finding that this reference teaches all limitations of these claims.

As discussed *supra*, Applicant respectfully traverses the Examiner's rejection in that YAMAGUCHI lacks the image data transmitting processor that transmits image data externally to a recording device, as claimed in claim 1 (and new independent claim 15), and also lacks the means for transmitting (and device that transmits) the image data to a computer provided externally to the image reading device, as claimed in claim 12. Rather, as discussed *supra*, YAMAGUCHI does not transmit image data, but transmits data to the service station 90 regarding a copying process at one of the copy machines 4-N, but not data representing

the actual image.

Also as discussed above, any perceived determination processor of YAMAGUCHI lacks the determination, *based on the state of said recording medium*, whether a recording operation of the recording medium is possible, as claimed in claim 1 (and new independent claim 15), and also lacks the means for determining (and device that determines), *based on a state of said recording medium*, whether a recording operation of said image data recording processor is possible, as claimed in independent claim 12 (emphasis added). If such was the case with YAMAGUCHI, then any determination must be made based on the state of the photosensitive drum, which is clearly not disclosed in this reference.

Also as discussed above, any perceived control processor of YAMAGUCHI does not prohibit the recording operation or allow image data to be transmitted to a peripheral device when the determination processor determines that the recording operation is impossible (as claimed in independent claims 1, 12 and new independent claim 15), but rather slows the copying process (*see, e.g.*, col. 10, lines 29-34) and stamps an image such as “invalid” across the copy (*see, e.g.*, col. 8, lines 60-66) and alerts the service station 90 (*see, e.g.*, col. 6, lines 55-62).

It is therefore respectfully submitted that for at least the above reasons, YAMAGUCHI, as well as the other references of record, fails to teach or disclose the invention of independent claims 1 and 12 (and new independent claim 15), as well as the

claims dependent therefrom.

Absent a disclosure in a single reference of each and every element recited in a claim, a *prima facie* case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claims 1 and 12 (and new independent claim 15), and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102(e).

With respect to the Examiner's above rejection of dependent claims 2-5 and the rejection of claims 6-11 under 35 U.S.C. § 103(a), since these claims are dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims recite additional features which further define the present invention over the references of record. It is thus respectfully submitted that all rejected claims are patentably distinct from the references of record.

Thus, Applicant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §§ 102 and 103, and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.

SUMMARY AND CONCLUSION

In view of the fact that none of the art of record, whether considered alone, or in any proper combination thereof, discloses or suggests the present invention, reconsideration of the Examiner's action and allowance of the present application are respectfully requested and are believed to be appropriate.

The amendment made to claim 12 has not been made to overcome a rejection based on the prior art or for any reason related to patentability. Rather, this claim has been amended to conform the marked-up and clean copies to each other in the Amendment submitted on July 10, 2002. These claims do not contain means-plus-function terminology. Thus, no estoppel should be deemed to attach to this amendment.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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MARKED-UP COPY OF CLAIM 12

12. (Twice Amended - Marked-Up Copy) An image reading device comprising:
[means for optically reading] a device that optically reads an image recorded on a recording material sheet to generate image data;
[means for transmitting] a device that transmits said image data to a computer provided externally to said image reading device;
[means for recording] a recorder that records said image data in a recording medium mounted in said image reading device;
[means for determining] a device that determines, based on a state of said recording medium, whether a recording operation of said image data recording processor is possible; and
[means for controlling said transmitting means and said recording means, said control means prohibiting] a device that controls said transmitting device and said recording device and prohibits said recording operation and [allowing] allows said image data transmitting [means] device to transmit said image data to said computer when said determining [means] device determines that said recording operation is impossible.